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APR 02 2004

OFFICE OF PETITIONS

In re Application of :
Huang, Jessen, Karthikeyan, Li, :
Oladeji, Steiner, and Taylor : DECISION REFUSING STATUS
Application No. 10/721,126 : UNDER 37 CFR 1.47(a)
Filed: 25 November, 2003 :
Attorney Docket No. Huang :
5-13-7-3-5-33-7/07 :

This is in response to the petition filed under 37 CFR 1.47(a) on 25 November, 2003.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 25 November, 2003, with a declaration naming Robert YS Huang, Scott Jessen, Subramanian Karthikeyan, Joshua Jia Li, Isaiah O. Oladeji, Kurt Geroge Steiner, and Joseph Ashley Taylor as joint inventors and signed by all joint inventors except Li on behalf of themselves and joint inventor Li.

The present petition was also filed on 25 November, 2003, whereby petitioners assert that joint inventor Li cannot be found to sign the declaration, as a copy of the declaration and an assignment sent to him were returned as undeliverable. Petitioners further

state that Li has moved to Singapore and that no forwarding address is available.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (3).

In regards to item (1), a showing of diligent effort requires that petitioners provide, with any renewed petition, a copy of the envelope showing that the letter sent to the non-signing inventor was returned as undeliverable by the U.S. Postal Service.¹ Further, if petitioners believe that Li is in Singapore, petitioners must show that diligent efforts were made to locate him.

Petitioners must present a showing that diligent efforts have been made to locate the non-signing inventor.² The showing of record is insufficient to prove that diligent efforts were made to locate the non-signing inventor. Petitioner should explain what attempts were made to obtain a forwarding address and to locate the inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. though e-mail, telephone, national registry) continue to fail, then applicant will have established that the inventor cannot be reached. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that the application was mailed and other attempts, such as telephone calls or e-mail searches, were made should be included.

¹See MPEP 409.03(d).

²MPEP 409.03(d).

Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.³ Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the application is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the non-signing inventor refuses to sign the declaration, petitioners must present proof thereof. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the declaration submitted with the application papers is defective in that (a) it contains non-initialed/non-dated alterations for joint inventor Oladeji.⁴ Petitioners should submit a new declaration, signed by joint inventor Oladeji, in compliance with 37 CFR 1.63 and 1.67.

In regards to item (3), Patent and trademark fees and charges payable to the U.S. Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable.⁵ A review of the papers filed with the present petition reveals that the requisite petition fee of \$130.00 was not enclosed. As such, the petition fee is a prerequisite to the filing of the present petition, and the Office will not reach the merits of the petition unless and until the petition fee is submitted. Any request for reconsideration of this petition must be accompanied by the petition fee.

³MPEP 409.03(d).

⁴See 37 CFR 1.52(c).

⁵37 CFR 1.22(a).

In regards to item (5), if a more recent last known address is discovered for joint inventor Li, that address must be provided with any renewed petition.

It is noted that the petition filed with this application is a copy of a petition filed in prior application No. 10/026,257, of which the present application is a continuation.

37 CFR 1.63(d)(3) provides, in pertinent part

Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(i) a copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c)

Petitioner has not provided a copy of the decision granting status under 37 CFR 1.47 in the prior application, No. 10/026,257. Petitioner must submit a copy of the decision granting status in the prior application with a renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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Office of Petitions